

REMARKS

The Office Action mailed November 3, 2006 has been received and reviewed. Claims 1-60 are in the case. Claim 1 stands objected to for an informality. Claims 1 and 22 stand rejected under 35 U.S.C. § 102(b). Claims 2-21, 23-60 stand rejected under 35 U.S.C. § 103(a).

By this paper, claim 1 has been amended. For the reasons set forth below, claims 1-60 are believed to be in condition for immediate allowance. Favorable reconsideration of the application in view of the following remarks, is therefore respectfully requested.

Objection to Claim 1

Claim 1 stands objected to for two informalities. First, the Office Action asserts that "scheme" as used in claim 1 is unnecessary because if there is a color, there is inherently a scheme. Second, the Office Action asserts that the "exposed portion and the covered portion" are drawn to the intended method of use of the object, and are not process steps in the claimed method of making the object.

With respect to the first objection, Applicant disagrees with the Office Action that the word "scheme" is unnecessary. Applicant finds that "selecting a base color scheme" is broader and more inclusive than "selecting a base color." While a base color certainly provides a color scheme, a base color scheme is not limited to a base color. A color scheme includes all the various colors and color combinations that one may select.

With respect to the second objection, Applicant has amended claim 1 to remove the language cited by the examiner. Reconsideration is, therefore, respectfully requested.

**Rejection of Claims 1 and 22 Under 35 U.S.C. §102(b)**

Claims 1 and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by De Paoli. However, for a prior art reference to anticipate, every element of the claimed invention must be identically disclosed in a single prior art reference. *See* MPEP §2131. Moreover, those elements must be arranged or connected together in a single reference in the same way as specified in the patent claim. *Id.* De Paoli does not meet this test.

For example, Applicant's newly amended claim 1 requires that the medallions be applied onto the top surface of a substrate. Applicant finds that the "spatter inserts" of De Paoli are applied in no such manner. *See* De Paoli at col. 2, lns. 1-15. As implied by the name "insert," De Paoli's spatter inserts are embedded into the base layer. *See* De Paoli at col. 4 lns. 17-18 (stating that the spatters are "located in the base layer to provide an ornamental design," emphasis added).

Moreover, Applicant's newly amended claim 1 requires curing together the substrate and the medallions, leaving the medallions bonded onto the top surface and extending above the top surface. Applicant finds no such disclosure in De Paoli. Rather, Applicant finds that De Paoli discloses using a hydraulic press and rollers to completely flatten the base layer and spatters of the terrazzo. *See* De Paoli at col. 2, lns. 11-13 and 71. After flattening, the spatter inserts of De Paoli would not extend above the top surface of the base layer of terrazzo. By completely flattening the terrazzo when it is malleable, De Paoli minimizes the grinding needed after the terrazzo has cured and hardened. *See* De Paoli at col. 2, lns. 15-19 and col. 3, ln. 2. Thus, De Paoli does not disclose all of the elements of Applicant's claims. Reconsideration is, therefore, respectfully requested.

**Rejection of Claims 2, 5-21, 23-29, 31-52, and 54-60 Under 35 U.S.C. §103(a)**

Claims 2, 5-21, 23-29, 31-52, and 54-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over De Paoli. However, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2143. De Paoli does not meet this test.

As presented hereinabove, Applicant's newly amended claim 1 requires that the medallions be applied onto the top surface of a substrate. Applicant finds that the "spatter inserts" of De Paoli are applied in no such manner. See De Paoli at col. 2, lns. 1-15. Moreover, Applicant's newly amended claim 1 requires curing together the substrate and the medallions, leaving the medallions bonded onto the top surface and extending above the top surface. Applicant finds no such teaching or suggestion in De Paoli. Reconsideration is, therefore, respectfully requested.

**Rejection of Claims 3, 4, and 30 Under 35 U.S.C. §103(a)**

Claims 3, 4, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over De Paoli in view of Arpin. However, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2143. The combination of De Paoli and Arpin does not meet this test.

As presented hereinabove, Applicant's newly amended claims require elements not taught or suggested by De Paoli. Adding the teachings of Arpin to those of De Paoli does not remedy the situation. As with De Paoli, Applicant does not find in Arpin any teaching or suggestion of applying a medallion onto the top surface of a substrate. Similarly, Applicant does not find in Arpin any teaching or suggestion of curing together the substrate and the medallions, leaving the

medallions bonded onto the top surface and extending above the top surface. Accordingly, reconsideration is respectfully requested.

**Rejection of Claim 53 Under 35 U.S.C. §103(a)**

Claim 53 stands rejected under 35 U.S.C. §103(a) as being unpatentable over De Paoli in view of Maletic. However, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP 2143. The combination of De Paoli and Maletic does not meet this test.

As presented hereinabove, Applicant's newly amended claims require elements not taught or suggested by De Paoli. Adding the teachings of Maletic to those of De Paoli does not remedy the situation. As with De Paoli, Applicant does not find in Maletic any teaching or suggestion of applying a medallion onto the top surface of a substrate. Similarly, Applicant does not find in Maletic any teaching or suggestion of curing together the substrate and the medallions, leaving the medallions bonded onto the top surface and extending above the top surface. Accordingly, reconsideration is respectfully requested.

**Rejection of Claims 12, 15-20, and 54-60 Under 35 U.S.C. §103(a)**

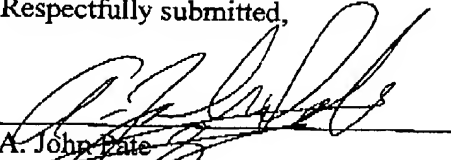
Claims 12, 15-20, and 54-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over De Paoli in view of Gundlach. However, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP 2143. The combination of De Paoli and Gundlach does not meet this test.

As presented hereinabove, Applicant's newly amended claims require elements not taught or suggested by De Paoli. Adding the teachings of Gundlach to those of De Paoli does not remedy the situation. As with De Paoli, Applicant does not find in Gundlach any teaching or suggestion of applying a medallion onto the top surface of a substrate. Similarly, Applicant does not find in Gundlach any teaching or suggestion of curing together the substrate and the medallions, leaving the medallions bonded onto the top surface and extending above the top surface. Accordingly, reconsideration is respectfully requested.

In the event that the examiner finds any remaining impediment to the prompt allowance of any of these claims, which could be clarified in a telephone conference, the examiner is respectfully urged to initiate the same with the undersigned.

DATED this 1<sup>st</sup> day of February, 2007.

Respectfully submitted,

  
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